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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/604,372	07/15/2003	Ian Boddy	71486-0051	1371
20915	7590	06/29/2005	EXAMINER	
MCGARRY BAIR PC 171 MONROE AVENUE, N.W. SUITE 600 GRAND RAPIDS, MI 49503			JUBA JR, JOHN	
			ART UNIT	PAPER NUMBER
			2872	

DATE MAILED: 06/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/604,372	BODDY, IAN	
	Examiner	Art Unit	
	John Juba, Jr.	2872	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-9,15, 17-26 and 29-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 41-43 and 50-55 is/are allowed.
- 6) ☒ Claim(s) 1,3-9,15,17-20,22-25,29-35,44-46,48 and 49 is/are rejected.
- 7) ☒ Claim(s) 21,26,36-40 and 47 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 22, 2005 has been entered.

It is noted that the clerical staff mistakenly entered the *copy* of the April 22, 2005 submission that was supplied with Applicant's RCE on June 15, 2005. Submission of a copy under these circumstances is certain to cause confusion or to precipitate a Notice of Non-Compliant Amendment. Applicant is reminded that, had the papers supplied on June 15, 2005 been accompanied by an instruction to enter these later papers as a new amendment in lieu of the submission under §1.116, it would have been appropriate to indicate the status of claims 44 – 55 as “unentered”, and to present these new claims as 56 – 67. Had the papers supplied on June 15, 2005 been accompanied by an instruction to enter *both* amendments, then the later status identifiers should have only included “Original”, “Previously Presented”, and “Cancelled”, since the claims would have been unchanged with respect to the amendment entered under §1.116. However, since the error here is on the part of the Office, prosecution will proceed without delay.

Claim Objections

Claim 46 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. As presented, claim 46 depends from itself.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 15, 17 – 20, 22, 23, 44 – 46, 48, and 49 are rejected under 35 U.S.C. 102(b) as being anticipated by Diaz (U.S. Patent number 4,318,220; of record). In its present scope, claim 46 is clearly anticipated by the heater element of Diaz, since only a heater element having slits is recited. With regard to claims 15, 44, and their respective dependent claims, the recitation of the heater element as being “for a vehicular mirror” and the recitation of the heater element as being “selectively sizeable *to conform to a size of a selected one of a plurality of mirrors*” [emphasis added] are clearly directed to the intended use of the heater element. Referring to the example, Diaz anticipates a 4 by 10 inch sample, stretchable to a 20-inch length. As such, the

element is capable of being re-sized to conform to the size of at least one truck mirror among the diversity of truck mirrors to be found in the prior art. Since the heater element of Diaz has all of the positively recited structure, and since the heater element of Diaz is clearly capable of the recited use, it is not clear how a recitation of the manner in which the heater element is to be used *structurally* distinguishes the claimed heater element over the prior art heater element.

Claims 15 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by NAVARRA DE COMPONENTES ELECTRONICOS (FR 2,666,717 A1; hereinafter "NAVARRA"). Referring to the figures and the English-language translation supplied by Applicant, NAVARRA disclose a heater for a vehicular mirror wherein the heater comprises a generally laminar body (transparent support layer and patterned layer), the body having a crenulated perimeter, wherein the perimeter of the heater element is selectively sizable to conform to a size (*i.e.*, the "dimensions") of a selected one of a plurality of mirrors. NAVARRA uses the expressions "shape of the surface" and "dimensions of the surface" independently. The examiner believes that one of ordinary skill would understand these as references to the surface figure and surface size (proportions), respectively. The expression "curved shape" in the Brief Description of Figure 4, clearly refers to a curved perimeter. It is clear the slits permit the conductors to be distorted and the space therebetween to be stretched or compressed in length. Referring to Figure 2, the heater element has an initially undeformed perimeter with an initial dimension. Referring to Figure 4, it should be apparent that, when the element is

Art Unit: 2872

applied to a circularly symmetrical mirror, the change in spacing between the conductors near the center of the mirror is smaller than the change in spacing at the perimeter of the mirror (the arc length changes as $r \cdot \theta$). That is, the heater element has a new perimeter wherein one side is made longer by a greater amount than the other side is made shorter, and thus the perimeter is made larger.

With regard to claim 17, where the length is stretched, the perimeter is also stretched.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3 – 9, and 29 – 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over NAVARRA (FR 2,666,717 A1), in view of VERRERIES HIRTZ SA (GB 2,250,406 A). NAVARRA disclose a heater element being formed from a sheet of heat conductive material (e.g., the dielectric support) having a crenulated perimeter, wherein the crenulated perimeter is sizable by distortion of the conducting elements (as discussed in the rejection of claim 15, above). The heater element is clearly for performing at least a defogging operation on the mirror. As set forth above, NAVARRA disclose the heater element substantially as claimed. However, NAVARRA do not disclose a housing or a mounting plate arranged as recited.

In the same field of endeavor, VERRERIES HIRTZ disclose a flexible heater element for an automotive mirror. VERRERIES HIRTZ teach that it is customary to dispose a heated automotive mirror assembly within a housing, to protect the mirror element. In order to facilitate mounting and adjustment of the mirror within the housing, VERRERIES HIRTZ teach the provision of a mounting plate (19) in register with the mirror, with the heater element mounted adjacent the mirror to the mounting plate within the housing. Further, VERRERIES HIRZT teaches that the purpose of heater elements in vehicle rear view mirrors is to perform both defogging and defrosting operations on the mirror.

It would have been obvious to one of ordinary skill to provide a mounting plate and housing for the heated mirror of NAVARRA, in the interest of protecting the mirror element with the housing, and in the interest of facilitating mounting and adjustment of the mirror within the housing, as suggested by VERRERIES HIRTZ. In accordance with the latter teaching, the elements would have been arranged as recited. Further, it would have been obvious to one of ordinary skill to provide the heater element of NAVARRA in a manner to perform both a defogging and a defrosting operation on the mirror, since VERRERIES HIRTZ teach that this is the usual purpose of such heating elements.

With particular regard to method claims 29, *et seq.*, NAVARRA fairly teaches the method steps, short of mounting the heater element in the housing adjacent the mirror. VERRERIES HIRTZ fairly suggest the additional step of mounting the heater element adjacent the mirror within a housing. Thus, it would have been obvious to one of

ordinary skill to perform the additionally recited steps, in the interest of protecting the heated mirror, as fairly suggested by VERRERIES HIRTZ.

Claims 24, 25, 34, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over NAVARRA and VERRERIES HIRTZ, and further in view of Holzer, et al (U.S. Patent number 5,099,104). As set forth above for claim 15, NAVARRA and VERRERIES HIRTZ discloses the invention substantially as claimed, including provision of a "mounting plate" within the specificity recited. However, NAVARRA and VERRERIES HIRTZ do not disclose the heater element as being wrapped around one edge of the mounting plate.

In the same field of endeavor, Holzer, et al disclose a heater element to be mounted to a support plate of glass. Referring to the discussion of Figure 5, Holzer, et al teach that a convenient means of electrically connecting to the heater element can be provided by wrapping the heater element around at least one edge of the support plate, and terminating the element with a lug. A profile frame (16) clamps the assembly securely together for installation.

It would have been obvious to one of ordinary skill to wrap the heater element around at least one edge of the support plate of NAVARRA and VERRERIES HIRTZ, in the interest of providing a convenient and secure lug for electrical connection of the heater element, as suggested by Holzer, et al.

With regard to claims 25 and 35, the profile frame (16) of Holzer, et al is fairly suggestive of a "bezel". Thus, it would have been obvious to one of ordinary skill to

provide a bezel clamping the wrapped edge as recited, in the interest of providing a secure mechanical assembly with means for mounting, as suggested by Holzer, et al.

Allowable Subject Matter

The previous indication of claim 18 as containing allowable subject matter is withdrawn in light of the claim construction discussed above. The examiner regrets the delay in applying the prior art in this manner, and apologizes for any inconvenience.

Claims 41, 42, 43 and 50 - 55 are allowable over the prior art. Claims 21, 26, 36 – 40, and 47 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The following is a statement of reasons for the indication of allowable subject matter:

The prior art, taken alone or in combination, fails to teach or fairly suggest
the *combination*, particularly wherein a rolled seam is provided cooperating as recited in claims 26, 36, 41, 50, and 51;

the *combination*, particularly wherein the heater element is provided as an elliptical spiral, in the manner recited in claims 38, 42, 43, and 53; or

the *combination*, particularly wherein the slits are contained wholly inwardly from the perimeter and are inclined relative to each other, as recited in claims 21, and 47.

Response to Amendment

In light of Applicant's remarks, the objection to the specification for allegedly including a trademark without proper identification is *withdrawn*. Applicant's amendment to the specification is noted with appreciation as clarifying the matter.

Applicant's amendment of claims 1, 15, and 29, is sufficient in overcoming the previous rejection of these claims under 35 U.S.C. §102(b) as being anticipated by Monter, et al (U.S. Patent number 4,942,286). Monter, et al do not disclose the step of stretching as recited in claim 29. Also, Monter, et al only disclose that the heater element is made by "known PTC technology" and thus do not provide information that would reasonably lead one to conclude that the disclosed heater element is *inherently* "sizeable by stretching". The examiner believes that this recitation clearly conveys that the element is capable of being stretched (to some extent) without yielding.

For the reasons explained above with regard to the new claim limitations, Applicant's amendment of claim 15 is not sufficient in overcoming the previous rejection of claims 15 and 17 under §102(b) as being anticipated by French patent number FR 2,666,717 A1.

Since French patent number FR 2,666,717 A1 is not deficient in the manner relied upon in Applicant's rebuttal, the rejection of claims 1, 3 – 9, and 29 – 33 under §103(a) as being unpatentable over NAVARRA (FR 2,666,717 A1), in view of VERRERIES HIRTZ SA (GB 2,250,406 A) stands as set forth above.

Similar, since French patent number FR 2,666,717 A1 is not deficient in the manner relied upon in Applicant's rebuttal, the rejection of claims 24, 25, 34, and 35

Art Unit: 2872

under §103(a) as being unpatentable over NAVARRA and VERRERIES HIRTZ, and further in view of Holzer, et al (U.S. Patent number 5,099,104) stands as set forth above.

Conclusion


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Juba whose telephone number is (571) 272-2314. The examiner can normally be reached on Mon.-Fri. 9 - 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Drew Dunn whose number is (571) 272-2312 and who can be reached on Mon.- Thu., 9 - 5.

The centralized fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306 for *all* communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2800.


JOHN JUBA, JR.
PRIMARY EXAMINER
Art Unit 2872

June 24, 2005